



3621
a legal professional association

Ralph E. Jocke

Patent
&
Trademark Law

June 5, 2002

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D. C. 20231

Re: Patent Application Serial No.: 09/193,565
Appellants: Drummond, et al.
For: Automated Banking Machine and System
Confirmation No.: 2182
Docket No.: D-1077+2

RECEIVED
JUN 18 2002
GROUP 3600

Sir:

Please find enclosed the Reply Brief of Appellants Pursuant to 37 C.F.R. § 1.193(b) in triplicate, for filing in the above-referenced case.

No fee is due with this filing. However, any fees deemed to be due may be charged to Deposit Account 09-0428.

Very truly yours,

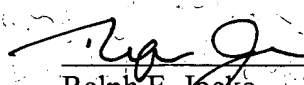

Ralph E. Jocke

REJ:tcp
Enclosures

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being sent postage prepaid as Express Mail Post Office to Addressee, in an envelope addressed to Board of Patent Appeals and Interferences, Commissioner for Patents, Washington, D.C., 20231, this 10th day of June 2002.

EV044422356US
Express Mail Label No.


Ralph E. Jocke

330 • 721 • 0000
MEDINA

330 • 225 • 1669
CLEVELAND

330 • 722 • 6446
FACSIMILE

rej@walkerandjocke.com
E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
Jay Paul Drummond, et al.)	
)	Art Unit 3621
Serial No.: 09/193,565)	
)	
Filed: November 17, 1998)	Patent Examiner
)	Pierre Eddy Elisca
For: Automated Banking)	
Machine and System)	

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

REPLY BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.193(b)

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 1.193(b), in triplicate, concerning the above-referenced Application.

RECEIVED

JUN 18 2002

GROUP 3600

REMARKS

The Examiner's Answer ("Answer") dated May 7, 2002 is acknowledged. The Answer apparently alleges that Appellants' Appeal Brief is noncompliant. That is, the Answer alleges

that the Status of Claims, Grouping of Claims, and Appendix sections of the Appeal Brief are incorrect. The Appellants disagree. Nevertheless, 37 C.F.R. § 1.192(d) provides that if a Brief is filed which does not comply with all of the requirements of 37 C.F.R. § 1.192(c), then the Appellant is to be notified of the reasons for noncompliance. Furthermore, the Appellant is to be given an appropriate time period to correct the defects. The Appellants have not been given a time period to correct the alleged defects.

Appellants have filed a petition that the Answer be withdrawn because it contains an impermissible new ground of rejection and because it is defective.

Status of Claims

The Answer alleges that the statement of the Status of Claims section of Appellants' Appeal Brief is incorrect. The Appellants respectfully disagree. The Answer's allegation is also confusing in light of the Answer's agreement (on page 3, line 1) that Appellants' statement of the Issues in the Brief is correct. The Answer alleges that the (Final) Office Action ("Action") dated September 19, 2001 contained the following rejections:

- 1). Claims 1-6, 13-14, and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson.
- 2). Claims 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson.
- 3). Claims 7-12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson.

The Appellants respectfully disagree. The Final Action dated September 19, 2001, from which their appeal was taken, only contained the following rejections:

- 1). Claims 1-6, 13-14, and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. ("Anderson").
- 2). Claims 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Official notice.

Claims 1-20 are pending in the Application. Thus, claims 7-12, being neither objected nor rejected, must be viewed as allowed. It follows that the statement of the status of the claims contained in the Appeal Brief is correct based on the Action from which this Appeal was taken. Thus, the Answer is incorrect, confusing, and defective.

An Office Action is presumed to be complete in accordance with 37 CFR § 1.104. There was no indication in the Final Action of a rejection of claims 7-12. Clearly, the Final Action did not include a specific identification of any ground of rejection of claims 7-12 in accordance with MPEP § 707.07(f). It follows that the Action does not include a rejection of claims 7-12. Additionally, neither the Final Action nor the prior Office Action dated April 16, 2001 included the rejection of claims 7-9 under 35 U.S.C. § 102(e) as being anticipated by Anderson. Nor does the Final Action include a rejection of claims 15-16 under 35 U.S.C. § 103(a) as being unpatentable over Anderson alone as asserted in the Answer. Claims 15-16 were actually rejected in the Final Action under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Official notice. The Answer at pages 7-8 provides further evidence that this pending

rejection is over Anderson in view of Official notice. Thus, the Answer incorrectly states the rejections on appeal.

The Answer is further confusing because the indicated Status of Claims does not correspond with the indicated Grounds of Rejection. For example, the Status of Claims indicates that claims 7-12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson, whereas the Grounds of Rejection contrarily indicates that claims 7-9 were rejected under 35 U.S.C. § 103(a) as set forth in Paper No. 7. Again, the Answer is plainly incorrect, confusing, and defective.

Appellants request that the decision by the Board of Patent Appeals and Interferences be based on the true pending rejections as correctly set forth in Appellants' Appeal Brief. Therefore, Appellants respectfully request that the Answer's incorrect allegations regarding the Status of Claims section of the Appeal Brief be disregarded.

The New Ground Of Rejection

In light of the above discussions, it is apparent that the Answer includes new grounds of rejection. However, 37 C.F.R. § 1.193(a)(2) clearly prohibits the entry of a new ground of rejection in an Examiner's Answer.

The Office's own procedures for examination clearly state that in order to enter a new ground of rejection after Appellants' Brief has been filed, the examiner, with supervisory approval, must reopen prosecution. Note MPEP § 1208.01 and 1208.02. However, there is no indication that prosecution has been reopened. Nor is there any indication of supervisory approval for reopening prosecution.

The Answer is incorrect, confusing, and defective. Therefore, Appellants respectfully request that the incorrectly listed rejections in the Answer, which constitute a new grounds of rejection, be disregarded. Appellants request that the decision by the Board of Patent Appeals and Interferences be based on the true pending rejections as correctly set forth in Appellants' Appeal Brief.

Grouping of Claims

The Answer alleges that the Appeal Brief does not include a statement that the claims do not stand or fall together. The Appellants respectfully disagree. The Appeal Brief (beginning on page 4) includes a Grouping of Claims section which states that "No group of claims stand or fall together." Thus, the Appeal Brief includes a proper statement that the claims do not stand or fall together. Thus, the Answer is incorrect, confusing, and defective.

The Appeal Brief (in the Argument section thereof) also explains why the claims are separately patentable.

Thus, the Appeal Brief includes both a proper statement that the claims do not stand or fall together and presents the reasons why the claims are separately patentable. It follows that the Answer incorrectly states the grouping of claims on appeal.

Furthermore, where an Appeal Brief includes only one of either (a) a statement that the claims do not stand or fall together or (b) presents arguments why the claims are separately patentable, then the Appellants are to be notified of a noncompliance as per 37 C.F.R. § 1.192(d). Note MPEP § 1206 (page 1200-11, col. 1, first paragraph; August 2001 version). However, Appellants were not notified of any noncompliance. Nor were Appellants given any appropriate

time period to correct any alleged defects in accordance with 37 C.F.R. § 1.192(d). Thus, it must be concluded that the Appeal Brief is in compliance with 37 C.F.R. § 1.192(c).

Therefore, the Grouping of Claims section in the Appeal Brief is correct. It follows that the Answer is incorrect, confusing, and defective. Therefore, Appellants respectfully request that the Answer's incorrect allegations regarding the Grouping of Claims section of the Appeal Brief be disregarded.

Appendix of the Claims in the Appeal

The Answer alleges (on page 3) that claims 1-6 and 13-20 in the Appendix section of the Appeal Brief contain substantial errors. The Appellants respectfully disagree. Nor has the Answer indicated where the "substantial errors" allegedly occur. The Appeal Brief Appendix contains a correct copy of the claims involved in the appeal.

Furthermore, the Answer indicates that there is a correct copy of the claims in an Appendix to the Answer. However, Appellants' copy of the Answer includes no claim Appendix.

Again, the Answer is incorrect, confusing, and defective. Therefore, Appellants respectfully request that the Answer's incorrect allegations regarding the Appendix section of the Appeal Brief be disregarded.

Rebuttal of comments in the Examiner's Answer

The Answer beginning at page 4, line 7 through page 9 is substantially similar to pages 2-6 of the Action. Appellants have already addressed the issues of record in their Appeal Brief.

CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000

Reg. No. 31,029